REMARKS

Applicant respectfully requests reconsideration of the application in view of the following remarks.

Status of Claims

Claims 39 and 43-48 remain pending and are not amended. These claims are presented for reconsideration.

Status of Co-Pending Applications

Applicant notes that a continuation of the instant application has been filed and was published as US 2009/0186944.

Applicant notes that a non-final Office Action was issued May 5, 2009, and a final Office Action was issued December 3, 2009, in co-pending application 11/249,122, which is already of record in the instant application. The Office Actions raise written description, indefiniteness and prior art rejections. These rejections are not believed to be material to patentability of the claims pending in the instant application. For example, to the extent the issues raised overlap with the subject invention, they are at best cumulative of issues previously raised and/or pending in the instant application.

§102(e) Rejections

The Office Action maintains the rejections of claims 39 and 43-48 under §102 (e) as allegedly anticipated by Bua (US 2004/0138214) and de Lignieres et al. (US 2005/0032909). Applicant respectfully traverses.

The Office Action acknowledges that a Rule 132 Declaration by the inventors was filed to remove both Bua and de Lignieres as prior art by another, but alleges that the Declaration is inadequate. In particular, the Office Actions states that "there is no indication that just because the inventors [of] the present application and the inventions [sic] of Bua and

de Lignieres worked for the same company that the invention stemmed from the present inventors." Applicant does not understand the basis for this finding.

With regard to Bua, the Declaration plainly states:

> The 4-hydroxy tamoxifen compositions within the scope of the pending claims that are disclosed in U.S. Patent Publication No. 2004/0138314 ***were derived from the undersigned inventors***, and were not invented by the inventor of U.S. Patent Publication No. 2004/0138314, Jay Bua.

Declaration, ¶ 3 (emphasis added). Likewise, with regard to de Lignieres, the Declaration plainly states:

> The 4-hydroxy tamoxifen compositions within the scope of the pending claims that are disclosed in U.S. Patent Publication No. 2005/0032909 ***were derived from the undersigned inventors***, and were not invented by the inventor of U.S. Patent Publication No. 2005/0032909, Bruno de Lignieres.

Declaration, ¶ 5 (emphasis added). Thus, the Declaration indeed attests that the invention at issue stemmed from the present inventors, although it uses the word "derived" instead of "stemmed."

MPEP § 2136.05 explains that an Applicant can overcome a §102(e) rejection "by showing that the disclosure is a description of applicant's own previous work," such as by showing that "the inventor(s) of the U.S. patent application publication . . . learned of applicant's invention from applicant." Similarly, MPEP § 716.10, states that, to overcome a §102(e) rejection, a Rule 132 Declaration should state "that the inventorship of the application is correct in that the reference discloses subject matter ***derived from the applicant rather than invented by the . . . applicant of the published application***." The Rule 132 Declaration submitted with Applicant's previous response provides such statements, as quoted above. *See* Declaration, ¶¶ 1, 3, 5.

MPEP § 716.10 states further that "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application ***will be accepted*** as establishing inventorship" unless "there is evidence to the contrary." Here, where there is no evidence to undermine the uncontradicted, unequivocal

statements made in the Rule 132 Declaration, which fully satisfies the requirements set forth in MPEP § 716.10 and 2136.05, the Declaration should be accepted to overcome the §102(e) rejections, which should be withdrawn.

Obviousness-Type Double Patenting Rejections

The Office Action provisionally rejects the claims under the doctrine of obviousness-type double patenting over two co-pending applications, US 11/009,390 and US 11/249,122. As noted previously, once these are the only issues remaining, the provisional obviousness-type double patenting rejections should be withdrawn in this application and imposed or retained in the '390 and/or '122 applications, if appropriate. This is because this application has an earlier effective U.S. filing date than applications US 11/009,390 and 11/249,122. *See* MPEP § 804(I)(B)(1) ("If a 'provisional' non-statutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.").

Conclusion

Applicant believes that the application is in condition for allowance, and an early notice to that effect is earnestly solicited. Should the Examiner find otherwise, Applicant respectfully requests that the Examiner contact the undersigned by telephone in order to discuss any remaining issues that might be readily resolved and so advance prosecution.

The Commissioner is hereby authorized to charge any additional fees, which may be required regarding this application under 37 CFR §§ 1.16-1.17, and to credit any overpayment to Deposit Account No. 19-0741. Should no proper payment accompany this response, then the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extension is needed for timely acceptance of submitted papers, Applicant hereby petitions for such extension under 37 CFR §1.136 and authorizes payment of the related fee(s) from the deposit account.

Respectfully submitted,

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